

REMARKS

Claims 1-9 and 27-59 are pending.

In the office action dated August 14, 2002, the Examiner maintained the rejection under Section 102(e) based on Yu et al., US Patent 5,998,171. As Applicants indicated in their previously filed response, it is Applicants' position that the Yu et al. patent is not a reference which qualifies as "prior art" under Section 102(e).

It would appear that the Office has not been able to establish a workable and equitable policy on the very issues presented by the instant application and the facts of this case. On the one hand, the Office is applying stringent utility and enablement requirements on pending patent applications and yet the Office has issued a category of patents, such as the Yu et al. patent, where the disclosure of such patents merely disclose a sequence and nothing more. Although the Yu et al. patent provides structural information concerning endokine alpha, it fails to teach one of ordinary skill how to use such an endokine alpha polypeptide (or a DNA encoding it). The patent provides no functional data to suggest how the endokine alpha polypeptide or its' DNA may be used.

The Examiner contends that a reference need not teach a utility in order for it to be anticipatory art. It is Applicants' position that the Office cannot and should not rely upon on certain decisions which are not applicable to the present situation in order to artificially construct a means by which to deal with patents such as Yu et al. that clearly do not meet the patentability requirements of utility and enablement, and which, if they had been examined pursuant to the current guidelines under Section 101 and 112, would never have issued as patents. The Examiner is referred to In re Wertheim, 646 F2d 527, 209 USPQ 554 (CCPA 1981), as well as MPEP 2136.03, sub-heading IV, which provide that the claims of a reference patent must be supported in the manner required by 35 USC 112 in the priority application whose date is relied on to establish the prior art status of the patent. The disclosure of such a priority application must include a use that supports the claims under Section 112. If it does not, that priority application is simply not available as part of the prior art.

In the event that the Examiner further maintains the instant rejection based on Yu et al., the undersigned may request suspension of examination of the instant application until such a time as the Office can establish an equitable policy with respect to the very issues presented in these circumstances.

Respectfully submitted,

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